

recipient.

18. System according to Claim 15, wherein the means for activating a secondary mobile station of the recipient as the receiver of user messages addressed to the primary mobile station comprises means for conducting the activation from the secondary mobile station to be activated.

REMARKS

Claims 1, 5, 6, 8, 10, 13, and 15 have been amended.

Claims 1 - 18 are in the case.

REJECTIONS:

In the Final Rejection in the parent case, Claims 1, 2, 4 - 6, 8 - 15, 17, and 18 were rejected under 35 U.S.C. § 102(b) as anticipated by the reference PEPE ET AL (US 5,742,905).

Also, dependent Claims 3, 7, and 16 were rejected under 35 U.S.C. § 103(a) as obvious and unpatentable over the reference PEPE ET AL (US 5,742,905) in view of the reference PEPPER ET AL (US 5,930,700) on the grounds that PEPE discloses all of the claimed features except user messages that are generated on the basis of the notification of calendar events, for which feature PEPPER was offered, and the combination concluded to render the invention as claimed obvious to the art.

In replying to the Applicants' arguments in the response to the previous Office Action to the Final Rejection, the Examiner contended that while Applicants' asserted that the pertinent devices of today, e.g., cellular phone, pager, and PDA, operate quite differently from the related devices taught by PEPE in 1994, their claims do not specify how user messages are differently handled today as distinguished from the handling in the prior art. Further, in response to the Applicants' insistence that there is a difference between a "notification" and a "message", it was contended that PEPE teaches the notification of a user by redirecting a text message (Abstract) and a text messaging technique which amounts to a short messaging service.

In the Advisory Action responding to Applicants' request for reconsideration of the Final Rejection, the Examiner contended that "(n)otifying a user that a message has been received by an alternative means is considered as 'user message' as claimed by applicant" and thus concluded that PEPE reads on the broad recitation of Applicants' claims.

REPLY:

The independent and appropriate dependent claims have been amended to overcome the confusion perceived by the Examiner regarding the meaning of the term "user messages" recited in Applicants' claims as compared to what constitutes a "notification message", i.e., a notification message indicates the receipt of a user message. The claims now contain language clearly defining and distinguishing between a "user message" and a "notification message" in a manner that would be unequivocally understood by those of skill in the art.

As recognized by the Examiner in the Advisory Action, PEPE discloses that a subscriber or user may have a notification, in the form of e-mail messages, of the receipt of a voice mail or fax message directed to a wireless PDA "primary mobile station", which notification can be routed to an alternate wireless or pager "secondary mobile station", if the primary mobile station is not turned on or otherwise operating. It is submitted that this "notification" of PEPE would not, as contended by the Examiner, be interpreted broadly by the art as equivalent to Applicants' user message, since it would be seen that PEPE's system needs a "wake-up" message before the notification message will be sent. For example, at Col. 6, lines 11 to 19, referred by the Examiner, it is disclosed that:

"...the subscriber may have notifications of a voice mail or fax message receipt directed to a wireless PDA in the form of e-mail messages. If the subscriber's wireless PDA is not turned on or otherwise not operating, the notification may be routed to an alternate wireless or wireline network. Notification to the subscriber that a voice mail message was received may be, for example, rerouted to the subscriber's pager, and notification that a fax has been received may be rerouted to the wireline e-mail." (Emphasis added).

Thus, the actual information of interest to the user is in the voice mail or fax, the "user message", which is the "wake-up" message to originate the sending of the "notification" message. The content of

the two messages are clearly not equivalent as recited in the amended claims and would be understood not to be by an artisan interpreting the claim definitions.

An illustration of the essential difference that one of skill would perceive between PEPE's teaching and Applicants' invention as defined in the claims may be seen if it is assumed that the "notification message" of PEPE is equivalent to the Applicants' "user message". Then, it would appear that PEPE teaches that the subscriber or user can direct the user messages to a wireless PDA, which is the primary mobile station, NOT a secondary mobile station, and that if the primary mobile station is not operating or receiving only then would the message be directed to the alternate secondary mobile station. Why does PEPE not disclose or suggest that the subscriber can direct the "user" messages addressed to the primary mobile station to a secondary mobile station irrespective of whether the primary mobile station is operating? Clearly because of the content of the message that is contemplated by PEPE. A notification message is only an indication that a user message, containing information, has been received, so that if the primary mobile station is not operating then the message is sent to another operating station or location to produce the desired notice to a user. The user, upon receipt of such notice, then may seek to access the user message to determine the information therein. In such event, since the user is already notified, retaining the notification message at the primary station would be redundant. However, if the content of the message includes the information for the user to access, then receiving the message at any station, primary or secondary or both, readily provides that information to the user wherever he may wish to retain and access it. Thus, the nature of the message, that is, its content, determines whether it is desirable to receive the message at one or all of the stations. Consequently, the "notification message" of PEPE is not equivalent to the Applicants' "user message" in view of this distinction. It is submitted that those of skill would appreciate this distinction and understand what is being claimed by Applicants as distinguished from what is taught by PEPE.

To reiterate Applicants' previous arguments as to what those of skill in the art would be led to understand from PEPE's teaching regarding what is defined in Applicants' claims, particularly as now amended. To begin with, one of skill in the art would readily

understand that Applicants' invention involves a method and system for handling **user messages**, which contain information for the user, as contrasted with a **notification**, which informs the user that a user message has been received but does not communicate the information in the message. For example, "You have 1 new voice mail in your voice mailbox" or "You have a new fax in your fax mailbox" is NOT a user message, but rather a notification of a new, received, user message, the message itself being the voicemail or fax. This distinction would be readily understood by the art and is not altered by the form of the notification, i.e, whether it is in text, symbol, or code format.

In evaluating what those of skill in the art would be led to understand from PEPE's teaching with respect to user messages and the other limitations defined in Applicants' claims, Applicants have earlier pointed out that a close reading of PEPE's description shows that those of skill in the art would appreciate that what was known at the time PEPE's application was filed is that the cellular phone, the pager, and the PDA devices of that day could not handle information which was different from the information tailored for use by the device, that is, a cellular phone could not handle pager messages, a pager could not handle e-mails, and a PDA could not handle phone calls. This is evidenced by PEPE's mentioning that the PCT device 40 may perform media conversion to allow, for instance, an incoming e-mail message to be delivered to a fax server (Col. 6, lines 3 - 5). Clearly then such an incoming message could not be directly received by the fax server without being converted by the PCT 40. Consequently, PEPE teaches it was not possible to redirect the transmitted information among the devices, e.g., incoming calls could not be directed to the PDA, or pager messages to the cellular phone, so that both the primary and secondary devices contemplated by PEPE were not capable of directly receiving "user messages". Furthermore, one of skill would understand that PEPE does not teach that the primary device and the secondary device can be similar devices, i.e., a PDA and a PDA, or a cellular phone and a cellular phone, since, as just explained, PEPE's devices function differently from each other and from those of Applicants' invention. It would be understood, by comparison, that all of the devices defined in Applicants' claims can handle the same kind of information, i.e., user messages, so that a secondary device can be used instead of the primary device to receive the information, and both can be similar devices. Conversion between different information formats is not

necessary in the system of Applicants' invention since the user messages have an information format receivable and usable by all of the receiving devices, primary and secondary.

It is noted that PEPE's **notification** can be rerouted (Col. 6, lines 11 to 19) to any of the recipient's devices, but PEPE does not teach that this rerouting includes the user message per se, i.e., with the information content. It will be seen that in accordance with Applicants' invention and as defined in the claims, such user messages, addressed to a recipient's primary mobile station, can be directed or rerouted to any one of the secondary mobile stations of the recipient, e.g., cellular phones, pagers, or PDAs, that can receive such messages with their information content. Hence, the system of PEPE only describes and teaches the art that a **notification, not the user message per se**, is sent to another device if the primary device is not operating, and the skilled artisan would clearly appreciate the difference between what is meant by a notification as distinguished from a user message in the defined context.

All of Applicants' independent claims 1, 6, 10, and 15 define that the primary mobile station and the secondary mobile station are capable of receiving the same kind of messages, i.e., "user messages", not merely, and irrespective of the receipt of, notifications of messages. A notification of a message, whether in the form of text or otherwise, would be understood by the art to constitute an indication that a message has been received, and would not be taken as meaning that the notification itself constituted the message per se with its information content. It is therefore submitted that all of Applicants' claims now patentably define over the teaching of PEPE. One other point is that the user message of Applicants' invention is "free-form", i.e., the sender can write anything he/she wants, include attachments, etc. The notification message of PEPE always depends on the actual "wake-up" message: it informs the type of message, sender, perhaps time of arrival, etc.

Further, with particular regard to the devices disclosed by PEPE and their inability to perform the operations defined in Applicants' claims, it is questioned on what basis one of skill would perceive that PEPE's device 32 corresponds to Applicants' claimed "primary mobile station", as concluded by the Examiner, or correspondingly, why some other of PEPE's devices would be perceived as a "secondary

mobile station". The only correspondence to be found is that the former is a mobile phone and the latter is a pager, but if a message is received in the mobile phone, the same message should be forwarded to the secondary station in the same form. One of skill is taught that PEPE's devices 22, 24, 26 and 20, are all not mobile devices, but instead, fixed devices positioned in an office environment. If a message is received in the primary mobile station, it should be received EITHER in the device 32 (mobile station), the pager 34, or the PDA 30. If it is received in the office devices, this means that the claim limitation "directing user messages addressed to primary mobile station" is not fulfilled by PEPE, because phone 26 is not mobile. It will be seen that PEPE's teaching deals with consumer premises equipment, which primarily constitute fixed devices. In contrast, Applicants' claims call for the original message to always be addressed to a mobile device. There is no such teaching in PEPE wherein the devices used are a fixed phone and a mobile phone, a fixed fax and a mobile fax, a fixed computer and a mobile computer (PDA). PEPE, as noted above, does not use two mobile phones or other duplicated devices. PEPE contains no teaching or suggestion of a primary mobile station AND a secondary mobile station as defined in Applicants' claims.

For example, if it is assumed that PEPE's mobile station 32 were indeed a primary station, it would follow that the user's message - which would be understood to be a voice message at the time PEPE was filed - would be forwarded to one of the secondary devices, i.e., to the PDA or the pager. However, this is not what actually takes place in PEPE's teaching. True, a phone call may be received in the pager, but the pager cannot be used for listening to the call. If the pager were a primary station, the only messages that it could receive would be phone calls, but, since the pager cannot be used for listening to the calls, it would not be a valid primary station. In PEPE the user of the pager does not forward the messages received to the pager, for example, to his mobile phone or PDA device. If the PDA were a primary station, this would require that it receive some communication. Figs. 28 to 45 suggest that the PDA could output CALL COMMAND, and it might be supposed that it can also receive calls and messages. However, to implement a procedure as defined in Applicants' claims, the user would have to turn off the PDA in order to redirect the incoming message to the PDA, instead of the mobile station 32.

Essentially in PEPE there are three types of mobile devices. One of skill considering the capability of the existing technology at the time PEPE was filed, must suppose that to implement PEPE system in the manner of the invention that the user would have to always carry all the devices with him; the mobile phone and the PDA being switched off and the pager being switched on. If, for example, a facsimile message is received, a notification message is then received in the pager. The user must carry the PDA device with him because it is needed for reading such messages which the mobile phone or the pager cannot read. If the user, for example, forgets to bring his PDA device, when the pager receives a notification of a new, received, facsimile message, the user has to fetch the PDA device in order to read the message. There is no mention in PEPE that the user might read incoming facsimile messages using the pager so that all of PEPE's devices are needed to attempt to perform the procedures that can be accomplished with Applicants' invention. Accordingly, PEPE's teaching neither anticipates nor suggests the combination of devices and steps defined in Applicants' claims.

Given the failures detailed above in the teaching of PEPE, there is nothing in the teaching of the PEPPER reference that in any manner can supply features which in combination with PEPE could render Applicants' invention obvious as claimed.

Based on the significant differences delineated above (and dealt with at length in the prior responses to Office Actions in this case) between Applicants' invention, as now particularly defined in the claims, and the teaching of PEPE, taken alone or with that of PEPPER, it is submitted that the cited art fails to render any of the Claims 1 - 18, as now submitted, unpatentable under 35 U.S.C. § 102(b) or 35 U.S.C. §103(a) so that they all should be allowed.

In summary, then, it is believed that this application is now in complete conformance with the requirements of the statutes and the claims are patentably distinguishable over the prior art, so that a prompt reconsideration and allowance of all of the claims and passage to issue of this application is earnestly solicited and respectfully requested.

Corrected formal drawings to replace the informal drawings filed with the application will be submitted upon allowance.

In the event that any additional fee is required for the entry and consideration of this response, it is authorized and requested that such fee be deducted from Deposit Account No. 16-1350, and the Amendment be timely entered.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the attached Amendment is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Box Non-Fee Amendment, Washington, DC 20231.

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SERIAL NO.: 09/138,218

Marked-up Claims

1. (Amended) Method for the transmission of user messages using a message service to the mobile station of a recipient, who has a primary mobile station capable of receiving at least voice calls and user messages, and at least one secondary mobile station, capable of receiving at least user messages, comprising the step of directing user messages addressed to the primary mobile station to any of the secondary mobile stations of the recipient, irrespective of whether the primary mobile station is in use and whether notification messages indicating the receipt of user messages are used.

5. (Amended) Method according to Claim 2, further comprising the steps of:

using a data computing device of the recipient for producing a notification message informing of a received user message to the recipient and to acknowledge the received user message by the recipient, and

first directing the received user message to the data computing device and, if the user message is not acknowledged by a determined time, forwarding the user message to the activated mobile station.

6. (Amended) System for the transmission of user messages from a sender to a recipient, who has a primary mobile station comprising at least means for receiving voice calls and means for receiving user messages, and at least one secondary mobile station comprising at least means for receiving user messages, wherein the improvement comprises:

means for activating a secondary mobile station of the

recipient to receive user messages addressed to the primary mobile station, and

means for directing user messages addressed to the primary mobile station to the activated secondary mobile station irrespective of whether the primary mobile station is in use and whether notification messages indicating the receipt of user messages are used.

8. (Amended) System according to Claim 6, further comprising:

a data computing device, which comprises means for receiving a user message and means for producing a notification message informing of the receipt of a user message,

means for first directing a user message to the data computing device,

means for measuring time and producing an indication if the means for producing a notification message informing of the receipt of a user message does not produce the informing message by a determined time, and

means, responsive to the production of said indication by said means for measuring time for forwarding the received user message to the activated mobile station of the recipient.

10. (Amended) Method for the transmission of user messages using a message service to a recipient having a primary mobile station, capable of receiving at least voice calls and user messages, and at least one secondary mobile station, capable of receiving at least user messages, comprising the steps of:

transmitting user messages addressed to the primary mobile station; and

activating at least one of said secondary mobile stations to receive said user messages addressed to the primary mobile station irrespective of whether the primary mobile station is in use and whether notification messages indicating the receipt of user messages are used.

13. (Amended) Method according to Claim 11, further comprising the steps of:

using a data computing device of the recipient for producing a notification message informing the recipient of a received user message and to acknowledge the received user message by the recipient, and

first directing the received user message to the data computing device and, if the user message is not acknowledged by a determined time, forwarding the user message to the activated mobile station.

15. (Amended) System for the transmission of user messages from a sender to a recipient having a primary mobile station, comprising at least means for receiving voice calls and means for receiving user messages, and at least one secondary mobile station, comprising at least means for receiving user messages, wherein the improvement comprises:

means for activating a secondary mobile station of the recipient to receive user messages addressed to the primary mobile station, and

means for directing user messages addressed to the primary mobile station to the activated secondary mobile station irrespective of whether the primary mobile station is in use and whether notification messages indicating the receipt of user messages are used.